

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AUGUSTO MARCHETTI

Appeal No. 95-2598
Application 08/021,230¹

ON BRIEF

Before COHEN, FRANKFORT and OWENS, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 23, 1993.

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This is a decision on appeal from the examiner's refusal to allow claims 1 and 3 through 8 as amended subsequent to the final rejection in a paper filed July 8, 1994 (Paper No. 8). Claim 2 has been canceled.

Appellant's invention relates to a machine for sealing foldable flaps of parallelepiped boxes with gum-coated paper tape. As noted on page 1 of the specification, it is an object of the invention to provide a box sealing machine that is of simple construction, easy maintenance, low cost and limited size. To that end, appellant has provided a unitary, modular tape feed assembly (6), seen best in Figures 3 through 8 of the application drawings, which is of compact size and is removably mounted on the arms (5) of the vertically moveable head (3). As noted in the specification (page 3), the tape feed assembly (6) itself is constituted by a plurality of individual units that can be taken apart separately. Those units (e.g., a tape roll supporting unit (11), a tape control unit (13), a tape centering unit (14), a tape feed unit (17), a contrast unit (18), a tape shearing unit (19), a tape moistening unit (20), and a tape application unit (21)), seen best in Figure 5, are removably fastened to a lateral

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supporting shoulder (8) of the tape feed assembly (6), or to
other of the individual constituent units of the assembly that

are removably mounted to the shoulder (8). Appellant indicates
on page 3 of the brief, that

[b]y providing a feed assembly which is
removable from the vertically moveable head
as a unit, and which also incorporates each
of the recited constituent components in such
a fashion that permits them to be independ-
ently disassembled from one another, the tape
machine of the present invention can be much
more easily repaired and serviced than those
known in the prior art.

Independent claim 1 is representative of the subject
matter on appeal and a copy of that claim is attached to this
decision.

The prior art of record relied upon by the examiner in
rejecting the appealed claims under 35 U.S.C. § 103 is:

Twigg	3,350,255	Oct. 31, 1967
Warshaw et al. (Warshaw)	4,061,526	Dec. 6, 1977
Ulrich et al. (Ulrich)	4,392,911	July 12, 1983
Cavanagh	4,642,157	Feb. 10, 1987

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Claims 1 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Warshaw in view of Ulrich.

Claims 4, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Warshaw in view of Ulrich as applied to claims 1 and 3 above, and further in view of Cavanagh.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Warshaw in view of Ulrich as applied to claim 1 above, and further in view of Twigg.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejections of the appealed claims under 35 U.S.C. § 103 will not be sustained. Our reasons follow.

A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight

reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. The examiner may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The proper test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. See Cable Elec. Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The law followed by our court of review, and thus by this Board, is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)(quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

In this case, considering the examiner's rejection of claims 1 and 3 under 35 U.S.C. § 103, we must agree with appellant that neither Warshaw, nor Ulrich, taken alone or in combination, discloses, teaches or suggests a tape sealing machine that has a tape feed assembly that is removable as a unit from a vertically movable head, which includes a unit for supporting a roll of gum-coated paper tape, a tape control unit, a tape

centering unit, a tape feed unit, a contrast unit, a tape shearing unit, a tape moistening unit, and a unit for applying the moistened tape to said boxes, and which is disassembleable into its individual constituent components (i.e., units), as required in claim 1 on appeal.

As best seen in Figures 1 and 2, Warshaw discloses an apparatus for sealing foldable flaps of a parallelepiped box (e.g., 20) with a tape (70), wherein the apparatus includes: a supporting base (11); transporting belts (15) for moving boxes along the supporting surface; a head beam (112) having a mounting seat internally thereof and being vertically movable along column (13) with respect to the supporting base; and at least one tape

applicator assembly, or tape feed and applying cartridge (21) removably mounted on the mounting seat of the head beam (col. 4, lines 23-26). While the examiner has indicated (answer, page 3) that the cartridge (21) of Warshaw includes knife means (76) for severing the tape, and first (34a) and second (42a) spring-mounted levers for supporting applicator rollers (122, 123) for applying tape to the boxes, the examiner has not otherwise pointed out where each of the other individual components or units of the tape feed assembly recited in appellant's claim 1 are found.

On pages 6-8 of the answer, the examiner additionally provides an explanation of why the roll (132) of tape, carried by the arm (133), in Warshaw is considered to be mounted to and part of the tape feed assembly (6). We agree with the examiner's reasoning, noting that Figures 1 and 2 of the drawings in Warshaw, as well as the disclosure incorporated by reference from the co-pending application Ser. No. 05/645,718 (now U.S. Patent 4,039,367), at column 1, lines 8-17 of the reference, clearly indicates that the arm (133) is mounted to the cartridge

internally of the head and thereby supported by the head beam (112). See column 4, lines 55-60, of U.S. Patent 4,039,367.

The examiner relies upon Ulrich as teaching a tape machine "in which means are provided to position or center the tape and control the tension thereof (col. 6, lines 37-42)" (answer, page 3). The examiner apparently additionally recognizes that neither Warshaw, nor Ulrich, teaches either gum-coated paper tape, or a tape moistening unit.

Based on the collective teachings of Warshaw and Ulrich, the examiner concludes that it would have been obvious to one of ordinary skill in the art to

have provided centering and control means for the tape in the apparatus taught by the primary reference [Warshaw], since Ulrich et al. recognize the desirability of centering and controlling the tension of a tape to be applied to a box. Gummed adhesives requiring moistening are well known in the art, and since each reference discloses adhesive tapes, it would have been obvious to provide moistening means for activating a gummed tape (answer, pages 3-4).

Even assuming that one of ordinary skill in the art would have found some motivation for modifying Warshaw in the

manner urged by the examiner relying on the teachings of Ulrich, and for using a gum-coated paper tape and a moistening unit therein as further urged by the examiner, we still do not see that the resulting tape machine would include a tape feed assembly having all of the individual constituent units set forth in appellant's claim 1 on appeal. In particular, we fail to find in the modified Warshaw tape machine a tape feed unit and a contrast unit forming part of the tape feed assembly as required in claim 1 on appeal, and also any teaching or suggestion of those units being constructed and arranged to function in the manner set forth in appellant's claim 3 on appeal.

Moreover, we fail to find in either of the applied references any teaching or suggestion of a removable tape feed assembly wherein the cartridge or assembly is disassembleable into its individual constituent components or units as required in appellant's claim 1. In this regard, we understand from appellant's disclosure, particularly Figure 5, that the last clause of claim 1 on appeal requires the specifically named units therein to be individual modules (units) that are separable from the tape feed assembly and each other to thereby facilitate ease of repair and replacement of such constituent units. No such

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individual constituent modules or units are disclosed or suggested in either Warshaw or Ulrich.

Based on the foregoing, the decision of the examiner rejecting claims 1 and 3 under 35 U.S.C. § 103 is reversed.

We have additionally reviewed the references to Cavanagh and Twigg applied by the examiner against dependent claims 4 through 8, however, we fail to find in these references anything which would supply the deficiencies already noted above with regard to the basic combination of Warshaw and Ulrich. In reviewing the teachings of Cavanagh and Twigg, as well as those of Ulrich, we are also of the opinion that the examiner has inappropriately relied upon hindsight and improperly used appellant's own disclosure and teachings as a guide through the prior art and the individual diverse elements thereof in selectively modifying the tape machine of Warshaw in the manner posited by the examiner so as to arrive at the claimed subject matter. As was made clear in Warner, supra, such a retrospective, hindsight reconstruction is not permitted by the examiner under 35 U.S.C. § 103. It follows that the examiner's

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rejections of claims 4 through 8 under § 103 will likewise not be sustained.

The decision of the examiner rejecting claims 1 and 3 through 8 on appeal under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
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TERRY J. OWENS)	
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APPENDED CLAIM

1. A machine for sealing foldable flaps of parallel-piped boxes with gum-coated paper tape, comprising:

a supporting base adapted to support boxes to be sealed;

means for moving said boxes along said supporting base;

a head having a mounting seat and being vertically movable with respect to said supporting base; and

at least one tape feed assembly constructed and arranged to apply sections of said gum-coated paper tape to said parallelepiped boxes and comprising a plurality of components including a unit for supporting a roll of gum-coated paper tape, a tape control unit, a tape centering unit, a tape feed unit, a contrast unit, a tape shearing unit, a tape moistening unit, and a unit for applying the moistened tape to said boxes,

said tape feed assembly being i) removably mounted on said mounting seat of said vertically movable head and ii) dis-assembleable into its individual constituent components including said unit for supporting said roll of gum-coated paper tape, said tape control unit, said tape centering unit, said tape feed unit, said contrast unit, said tape shearing unit, said tape moistening unit, and said unit for applying the moistened tape to said boxes.